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0212.67615

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Timothy Baker
Serial No.:	10/648,048
Conf. No.:	3223
Filed:	08/26/2003
For:	POWER HAND TOOL RIGHT ANGLE ATTACHMENT HAVING A LIGHT SOURCE WITH A SELF-GENERATING POWER SUPPLY
Art Unit:	3724
Examiner:	Choi, Stephen

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date.

8/14/2008
Date

Attorney for Applicant(s)
Registration No. 26,174

TRANSMITTAL OF REPLY BRIEF

MS Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith:

(X) Reply Brief Pursuant to 37 CFR §§ 41.41 with respect to the Examiner's Answer mailed on June 16, 2008.

No fee is required for filing this Rebuttal Brief.

(X) The Commissioner is hereby authorized to charge any additional fee which may be required, or credit any overpayment to Deposit Account No. 07-2069. Should no proper payment be enclosed, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-2069. (One additional copy of this Notice is enclosed herewith.)

Dated: August 14, 2008

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APPELLANT'S REPLY BRIEF ON APPEAL PURSUANT TO 37 CFR § 41.41

This Brief is in reply to the Examiner's Answer mailed June 16, 2008.

The examiner cites a number of cases for the proposition that the combination of references relied upon is proper because appellant's claim 1 involves no more than "a simple substitution of one known element for another" or "a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results", with those cases citing back to *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727.

Appellant relies on *In re Kahn* in its appeal brief and points out that *In re Kahn* is cited with approval in *KSR*. More specifically, *KSR* quotes from *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness."

The examiner's rejections are based upon such conclusory statements and are highly speculative with regard to motivation and modifications to the prior art references that are necessary. The required modifications are not simple substitutions of one known element for another. It is also highly speculative that the examiner's combinations would not be uniquely challenging, particularly when the construction of the examiner's cited references to be combined are so different.

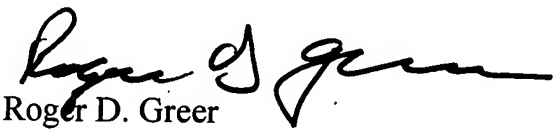
Appellant also notes that it is improper to combine references where the references teach away from their combination. (*In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). This principle was cited with approval in *KSR*. The Supreme Court in *KSR* discussed in some detail *United States v. Adams,* 383 U.S. 39 (1966), stating in part that in that case, "[t]he Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." Accordingly, it remains improper to combine references where the references teach away from their combination.

This recognition that teaching away can be a strong argument for nonobviousness, diminishes the importance of whether there is a change in the respective functions of old elements that are combined, or whether a combination yields predictable results. It is a recognition that a finding of obviousness is not a necessary result when old elements are combined to produce predictable results.

The claims on appeal here are believed to define patentable subject matter and should be allowed. Such action is respectfully requested.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By 
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